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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SPERTY, ARDEN B

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 12/05/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/824,244

Applicant(s)

BETHUNE ET AL.

Examiner

Arden B. Sperty

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 14-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's arguments regarding the restriction requirement have been considered but are not persuasive for the following reasons:

Applicant has not shown that the intermediate product in the relationship of Inventions I and II cannot be used to make a different final product, such as a decorative object.

Applicant has not shown that the product could not be made by the alternate process of depositing a first metal, masking a design pattern and depositing a second metal.

2. The restriction is final.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because it is not clear what the maximum number of layers should be for the second metallic coating. It is also unclear whether n of the first metallic coating is the same as n of the second metallic coating.

112  
Claim 2 is indefinite because it does not actually require that the metallic coatings be provided by electrodeposition or galvanoplasty.

Claim 3 is indefinite because it is unclear what is meant by 'zamak.'

Claim 4 is indefinite because it is unclear what is intended by 'filled.'

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,505,320 to Burns et al.

Regarding claim 1, the Burns reference discloses a support having a first metallic coating of n=2 layers, designated 2 and 3, and a second metallic coating of n=1 layer, designated 4, wherein the outer metallic layer (3) of the first metallic coating is Cu and has a color and appearance differing from that of the outer metallic layer of the second metallic coating of Cr (col 3, line 22- col 4, line 18). As shown in Figure 5, the first metallic coating delimits a decorative pattern and the second metallic coating corresponds to the decorative pattern.

Regarding claim 2, USPN 4,971,188 to Deters is cited to show that plastics similar to those disclosed by Burns may be metallurgically coated by a galvanoplasty process (col 2, lines 8-10 and 45-48). Galvanoplasty is a type of electrodeposition, therefore the limitations of the claim are met; however, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. Since the product in the product-by-

process claim is the same as the product of the prior art, the claim is unpatentable regardless of the process used to make the prior art.

Regarding claim 3, the Burns reference discloses the object according to claim 1 wherein the support is a polyester (col 2, line 64).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-2 and 4-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,445,982 to Royer.

Regarding claims 1 and 13, the Royer reference discloses a method for producing an object comprising a support having a first metallic coating delimiting a decorative pattern and a second metallic coating having  $n=1$  layer covering the surface of the support in a region corresponding to the decorative pattern wherein the outer metallic layer of the first metallic coating has a color and appearance differing from that of the outer metallic layer of the second metallic coating (col 2, line 61-col 3, line 4). Although the reference does not specifically disclose the first metallic coating as having  $n \geq 2$  or  $n=3$  layers, absent a showing of criticality with respect to a specific number of layers it would have been obvious to form several (i.e.  $n \geq 2$  or  $n=3$ ) layers depending on the ultimate intended use of the object and the desired degree and type of decoration (col 3, lines 26-32).

Art Unit: 1775

Regarding claim 2, the reference discloses the metallic layers formed by electrodeposition (col 2, lines 22-23).

Regarding claims 5 and 6, the outer metallic layer of the first metallic coating is silver and the outer metallic layer of the second metallic coating is gold (col 2, line 61-col 3, line 4).

Although the reference does not specifically disclose the other metallic layer materials of claims 5-7, absent a showing of unexpected results with the specific metals it would have been obvious to one ordinary skill in the art to use any of the listed metals of contrasting color with a reasonable expectation of success in producing a decoration of two different metals on the surface of an object.

Regarding claims 4 and 8, the object is in the form of a cigarette lighter, which is a container filled with lighter fluid (col 2, lines 57-61).

Regarding claims 9-12, absent a showing of criticality with respect to the shape (stopper, accessory associated with a container, having a cylindrical skirt) of the object it would have been obvious to one of ordinary skill in the art to use an object having any of the claimed container shapes depending on the ultimate intended use or desired aesthetic design. Requiring a particularly shaped object without providing the criticality thereof does not provide patentable distinction over the prior art.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Royer as applied to claim 1 above, and further in view of USPN 5,525,421 to Knoerzer.

Regarding claim 3, the Royer reference discloses the object of claim 1 wherein the support is made of plastic (col 3, lines 21-25). Knoerzer discloses plastics such as polypropylene

Art Unit: 1775

with a metallic coating (col 1, line 1-col 2, line 10) having greater flexibility than metallic foils. Although the Royer reference does not specifically disclose the types of plastics that may be used, it would have been obvious to one of ordinary skill in the art to use polypropylene as the plastic material because it is well known in the art that metal-coated plastics are advantageous over metal foils because of their flexibility (Knoerzer, col 1, lines 8-13). Absent a showing of criticality with the other claimed plastic materials, it would have been obvious to use any of the claimed plastics as a functional equivalent to polypropylene.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arden B. Sperty whose telephone number is 703-305-3143. The examiner can normally be reached on M-R, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 703-308-3822. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

*AB Sperty*

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December 2, 2002

*Cathy Lam*  
**CATHY LAM**  
**PRIMARY EXAMINER**